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| 10/516,470   | 01/28/2005  | Chris McEvilly       | Q85082              | 6747             |
| 23373 7590 12/17/2008<br>SUGHRUE MION, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| CHOKSHI, PINKAL R  |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/516,470

**Applicant(s)**

MCEVILLY ET AL.

**Examiner**

PINKAL CHOKSHI

**Art Unit**

2425

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15, 17, 18, 20, 21, 23, 28, 32, 34-36, 39 and 40 is/are allowed.
- 6) ☒ Claim(s) 51-53, 63, 65, 70-73, 76-78, 92, 106 and 144-147 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-15,17,18,20,21,23,28,32,34-36,39,40,51-53,63,65,70-73,76-78,92,106 and 144-147.

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 11/13/2008, with respect to the rejection(s) of claim(s) 1 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. See the new rejection below.

***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- Claims 144 and 146 claim computer readable medium which is not defined in the specification.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 145 and 147** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 above. Claims 145 and 147 are claiming a program per se.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 51-53, 63, 65, 70-73, 76-78, 92, 106, and 144-147** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,619,247 to Russo (hereafter referenced as Russo) in view of US PG Pub 2002/0154892 to Hoshen (hereafter referenced as Hoshen).

Regarding **claim 51**, "a user device for use in a content delivery system" reads on a stored program pay-per view system that includes a device at a subscriber's site and regional servers that provides pay-per view contents located at a cable provider's site (abstract and col.3, lines 24-28) disclosed by Russo and represented in Fig. 1.

As to "the user device comprising: a first receiver operable to receive user input" Russo discloses (col.9, lines 33-34) that the infrared receiver receives input from user using remote control as represented in Fig. 2 (element 162).

As to "a transmitter operable to transmit, in response to a first user input identifying content to be recorded, a request to a remote capture system to capture the content identified by said first user input" Russo discloses (col.3, lines 60-64) that the communication link in the STB communicates with the cable

system ordering facilities. Russo further discloses (col.9, lines 59-65) that in order to store a program material in the STB for subsequent replay, user selects a program from the broader categories, where selected program, received from service provider, is automatically downloaded.

As to "a second receiver operable to receive captured and processed content data from said remote capture system" Russo discloses (col.6, lines 54-58) that the tuner in STB receives content data as represented in Fig. 2 (element 104).

As to "a storage device for storing the captured and processed content data received by said second receiver" Russo discloses (col.4, lines 10-13) that the selected program materials by viewer is stored in the program storage unit as represented in Fig. 1 (element 14).

As to "a playout unit operable to playout the contents stored on the storage device" Russo discloses (col.9, lines 28-32) that the controller communicates with storage device to playout the content data as represented in Fig. 2 (element 150).

Russo meets all the limitations of the claim except "whereby the user device initiates server side capture of the content, provides client side storage of the captured content, and initiates playout of the captured content under server side control by receiving a remote transmission indicating permission to playout the content from the server side." However, Hoshen discloses (§10021 and §10067) that upon receiving a request to view a program from a STB,

management system controls the playout of stored content in STB located in the same cluster. Hoshen further discloses (§0088) that the management system controls all the STBs within the cluster and provides access to stored content of a STB based on the request received from a STB. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of invention to modify Russo's system by using server to control the playout of content from STB as taught by Hoshen so the billing system at the server end can charge subscriber or view user's activity every time when user plays stored content or make a copy of the stored content.

Regarding **claim 52**, "a system wherein said capture system is operable to transmit said captured content data together with said tag data to said second receiver of said user device and wherein said storage device is operable to store both the captured content data and the generated tag data" Hoshen discloses (§0085) that the headend manages content data that includes title id, broadcast time information. In addition, same motivation is used as to reject claim 51.

Regarding **claim 53**, "a system wherein said playout unit is operable to control the playout of said stored content data in dependence upon on the tag data associated with the content data" Hoshen discloses (§0085) that the STB plays programming content based on the message received that includes time. In addition, same motivation is used as to reject claim 51.

Regarding **claim 63**, “a user device operable to receive said captured and processed content data at a data rate which is less than a data rate required for real time playback of the content by said playback unit” Hoshen discloses (§10174) that the subscriber can issue stop, pause, fast forward, and rewind commands after ordering programming content. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to use the control unit to control the program and plays the content at different rate as taught by Hoshen in order to provide an option to rewind/forward/pause the video based on user's need.

Regarding **claim 65**, “a user device is operable to transmit a recorded content playback request to said capture system and wherein said capture system is operable to redirect the user to the storage device containing the requested content” Hoshen discloses (§10066 and §10067) that the STB selects a program playback request to management system that locates a requested program stored in the STB and assigns it. In addition, same motivation is used as to reject claim 51.

Regarding **claim 70**, “a capture system for use in a content delivery system” reads on a stored program pay-per view system that includes a device at a subscriber's site and regional servers that provides pay-per view contents



located at a cable provider's site (abstract and col.3, lines 24-28) disclosed by Russo and represented in Fig. 1.

As to "the capture system comprising: a receiver operable to receive a user request from a remote user device, identifying content to be captured" Russo discloses (col.9, lines 33-34) that the infrared receiver receives input from user using remote control as represented in Fig. 2 (element 162).

As to "a capture device operable to capture and process content data as it is broadcast from a content broadcaster in accordance with said user request" Russo discloses (col.3, lines 60-64) that the communication link in the STB communicates with the cable system ordering facilities. Russo further discloses (col.9, lines 59-65) that in order to store a program material in the STB for subsequent replay, user selects a program from the broader categories, where selected program, received from service provider, is automatically downloaded.

As to "a transmitter operable to transmit captured and processed content data to said remote user device for storage therein" Russo discloses (col.9, lines 59-65) that in order to store a program material in the STB for subsequent replay, selected programs are received from service provider and is automatically downloaded to STB.

Russo meets all the limitations of the claim except "wherein, in response to a request from the remote user device for playout of the transmitted content data, the capture system is operable to make a determination as to whether the playout request should be granted, and responds to the request based on the

result of the determination.” However, Hoshen discloses (¶¶0021 and ¶¶0067) that upon receiving a request to view a program from a STB, management system controls the playout of stored content in STB located in the same cluster. Hoshen further discloses (¶¶0088) that the management system controls all the STBs within the cluster and provides access to stored content of a STB based on the request received from a STB. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of invention to modify Russo’s system by using server to control the playout of content from STB as taught by Hoshen so the billing system at the server end can charge subscriber or view user’s activity every time when user plays stored content or make a copy of the stored content.

Regarding **claim 71**, “a system wherein said capture system is operable to process said captured content data to determine tag data identifying the timing of content segments within the captured content” Hoshen discloses (¶¶0085) that the headend manages content data that includes title id, broadcast time information. In addition, same motivation is used as to reject claim 70.

Regarding **claim 72**, “a system wherein said capture system is operable to transmit said captured content data together with said tag data to said second receiver of said user device and wherein said storage device is operable to store both the captured content data and the generated tag data” Hoshen discloses

(¶0085) that the headend manages content data that includes title id, broadcast time information and transmit this data to STB to store this content data with timing information. In addition, same motivation is used as to reject claim 70.

Regarding **claim 73**, "a system wherein said capture system includes a video server operable to capture video data as it is broadcast by said content broadcaster" Hoshen discloses (¶0072) that the management system includes a central server where the connection to these channels can be performed via a DVB to receive the channel from head-end. In addition, same motivation is used as to reject claim 70.

Regarding **claim 76**, "a system wherein said capture system includes a database, wherein said receiver is operable to store received user requests for content recorded in said database and further comprising a scheduler operable to process the requests stored in said database together with program guide data identifying the timing at which content is to be broadcast by said content broadcaster, to control the capturing of content by said video server" Hoshen discloses (¶0024 and ¶0164) that the management system receives the request to view the program content from the STB and based on this request, management system registers this request and transmits a list of programs available along with the programs recorded on the STBs. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention

to modify Russo's system by registering/storing user's requests in server's database as taught by Hoshen in order to keep tracks of user's activity for billing and accounting purposes (§10164).

Regarding **claim 77**, "a system wherein said scheduler is operable to provide channel data identifying the channels to be recorded together with data identifying the start and end time for the recordings" Hoshen discloses (§10085) that the management system manages database of the programming content data that includes channel number, name, program start/end time which is to be stored on the STB. In addition, same motivation is used as to reject claim 70.

Regarding **claim 78**, "a system wherein said capture system is operable to generate a contents schedule for each piece of content captured by the capture system, which contents schedule identifies a sequence of content portions of captured content to be played out by the playout unit of said user device" Hoshen discloses (§10065 and §10077) that the management system distributes EPG of stored programs to subscribers. In addition, same motivation is used as to reject claim 70.

Regarding **claim 92**, "a system wherein said transmitter is operable to transmit the captured and processed content data to said user device at a data rate which is less than a data rate required for real time playout of the content by

said playout unit" Hoshen discloses (§0174) that the subscriber can issue stop, pause, fast forward, and rewind commands after ordering programming content. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to use the control unit to control the program and plays the content at different rate as taught by Hoshen in order to provide an option to rewind/forward/pause the video based on user's need.

Regarding **claim 106**, "a content delivery method comprising: transmitting from a user device in response to a user input, a request to a remote capture system to capture content identified by the user input" reads on a stored program pay-per view system that includes a device at a subscriber's site and regional servers that provides pay-per view contents located at a cable provider's site (abstract and col.3, lines 24-28) disclosed by Russo and represented in Fig. 1.

As to "receiving the user request at the remote capture system and capturing and processing the identified content when it is broadcast from a content broadcaster" Russo discloses (col.9, lines 33-34) that the infrared receiver receives input from user using remote control as represented in Fig. 2 (element 162). Russo discloses (col.3, lines 60-64) that the communication link in the STB communicates with the cable system ordering facilities. Russo further discloses (col.9, lines 59-65) that in order to store a program material in the STB for subsequent replay, user selects a program from the broader categories,

where selected program, received from service provider, is automatically downloaded.

As to “transmitting the captured and processed content data to said user device” Russo discloses (col.6, lines 54-58) that the tuner in STB receives content data as represented in Fig. 2 (element 104).

As to “storing the content data received by said user device in a storage device of the user device” Russo discloses (col.4, lines 10-13) that the selected program materials by viewer is stored in the program storage unit as represented in Fig. 1 (element 14).

Russo meets all the limitations of the claim except “retrieving, in response to a user input, provided from the user device to the remote capture system, and identifying stored content to be played out, the content identified by said user input from said storage device and playing out under control of the remote capture system the retrieved content to an associated user.” However, Hoshen discloses (¶0021 and ¶0067) that upon receiving a request to view a program from a STB, management system controls the playout of stored content in STB located in the same cluster. Hoshen further discloses (¶0088) that the management system controls all the STBs within the cluster and provides access to stored content of a STB based on the request received from a STB. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of invention to modify Russo’s system by using server to control the playout of content from STB as taught by Hoshen so the billing system at the

server end can charge subscriber or view user's activity every time when user plays stored content or make a copy of the stored content.

Regarding **claims 144, 145, 146, and 147**, "a computer readable medium storing computer executable instructions for causing a programmable computer device to become configured as the user device of claim 51/70." However, the Examiner takes official notice that it was well known in the art at the time of the invention to store computer program on computer readable medium. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to store computer readable program on recorded medium to Russo and Hoshen's systems would have yielded predictable result of easily installing program on the other computer devices.

***Allowable Subject Matter***

6. **Claims 1-15, 17, 18, 20, 21, 23, 28, 32, 34-36, 39 and 40** are allowed. The following is a statement of reasons for the indication of allowable subject matter: The present invention comprises a user device at the client's side and a capture system located remote at the server side wherein the user device transmits a request to record the content data on its storage unit to the capture system wherein the capture system transmit user's requested content data to a user device in which the playout of the content data stored in the user's storage device is enabled under control of the server

side of the content delivery system. Furthermore, capture system creates a GUI defining the record of the content stored in the storage device of the user device.

The closest prior art, Russo, Hoshen, and Marko show a similar system. However, Russo discloses a stored program pay-per-view system that plays content stored on the receiver, Hoshen discloses content on demand stored on STB with the control of playout of this content is at the server side, and Marko discloses a receiver unit that is configured to obtain authorization from a remote distribution center to decrypt locally stored content segments. Thus, Russo, Hoshen, and Marko do not disclose nor suggest that the capture system located at the server side creates a GUI defining the record of the content stored in the storage device of the user device; graphical user interface identifies content that has been captured by said capture system in response to a request received by said user device and content that has been captured automatically by said capture system based on a user profile for the user associated with the user device; the graphical user interface is operable to communicate inputs from the user to the server side of the content delivery system, whereby a request from the user to retrieve and playout content stored in the storage device of the user device is provided to the server side of the content delivery system, as required by claim 1.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PINKAL CHOKSHI whose telephone number is (571)



270-3317. The examiner can normally be reached on Monday-Friday 8 - 5 pm (Alt. Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pinkal Chokshi/  
Examiner, Art Unit 2425

/Brian T. Pendleton/  
Supervisory Patent Examiner, Art Unit 2425